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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,450	08/06/2002	Assaf Dekel	110/01309	6918

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EXAMINER	
DAVIS, DANIEL J	

ART UNIT	PAPER NUMBER
3731	

DATE MAILED: 07/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/031,450	DEKEL, ASSAF	
	Examiner	Art Unit	
	D. Jacob Davis	3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 May 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-60* is/are pending in the application.

4a) Of the above claim(s) *57-60* is/are withdrawn from consideration.

5)☒ Claim(s) *56* is/are allowed.

6)☒ Claim(s) *1-50 and 52-55* is/are rejected.

7)☒ Claim(s) *51* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Newly submitted claims 57-60 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the apparatus claims as recited may be used to perform a materially different method, such as abrading a door.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 57-60 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, "the means for affixing" of claim 51 must be shown or the feature canceled from the claim. No new matter should be entered. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be

renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 28 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specific bioabsorbable materials are not disclosed. No new matter may be entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-27, 32, 37, 39, 40-42 and 44-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 2,372,553 to Coddington. Coddington discloses an apparatus for removing bone comprising a handle 14, first and second extensions 13 and a flexible rasp. The outer surfaces of the extensions contacting the rasp 10 comprise the first and second tips. The central portions of the extensions 13 comprise the pick reel/rasp advancer. The device comprises a shield 15. Alternatively, the shield may comprise the smooth backing 10 as illustrated in figure 4. The shield of the smooth backing and the rasp are fully capable of being removed, inverted, and replaced to change the "relative positions." The central portion of the extensions 13 comprises a resting point. The water X is a source of cleaning fluid. The reels are two separate parts during normal use. An end of the band constitutes a "leader." The device comprises a rasp advancer including the axel of the reel.

Coddington fails to disclose that the flexible rasp is "adapted for passage through a spinal channel of a live human" since the rasp appears to be one monolithic loop, which cannot be placed within the vertebral channel of a live human. Nevertheless, It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the band separable (and reattachable) since it has been held that constructing a formerly integral structure in various

elements involves only routine skill in the art. A separable flexible file may be passed through vertebrae.

Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the band separable (and reattachable) enabling a user to easily remove and replace the band from the reels.

Regarding claims 15-19, 40 and 41, Coddington fails to disclose that the width of the rasp is less than 2 mm. Nevertheless, it has been held that mere changes in size are within the level of ordinary skill in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the rasp width less than 2 mm.

The length of the rasp is not specified. Nevertheless, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the rasp between 1 and 3 meters or any length as needed.

Respecting claims 20-23, Coddington fails to disclose the thickness of the rasp. Nevertheless, the patent discloses in column 1, lines 13-17 the desirability to make the thickness small. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the thickness less than .1 mm to increase flexure and extend the cutting life.

Claims 52-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coddington in view of U.S. Patent No. 3,523,348 to Nilsson. Coddington fails to disclose a spring and to maintain tension. Nevertheless, Nilsson teaches a spring (F) and gauge (G) to tension and

measure the tension of the abrader. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Coddington device as taught by Nilsson to include a spring and gauge to maintain a measured amount of tension in the Coddington device when in use.

Claims 43-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coddington in view of U.S. Patent No. 2,355,124 to Testo. Coddington fails to disclose that the active length is adjustable. Nevertheless, Testo discloses an adjustable active length to change the size according to the particular needs of a user.

Coddington is silent regarding the exact size of the active length. However, the reference compares the device to a band saw (column 1, lines 1-7), giving the impression that it might be about the size of a small abdomen. Nevertheless, it has been held that mere changes in size are within the level of ordinary skill in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the active length to span between two and ten adult vertebra.

Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Coddington in view of U.S. Patent No. 5,713,785 to Nishio. Coddington fails to disclose a vacuum source. Nishio teaches a vacuum source for "exhausting dust emitted during the sanding" (Abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a vacuum source as taught by Nishio in order to capture airborne particles.

Allowable Subject Matter

Claim 56 is allowed.

Claim 51 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed May 9, 2005 have been fully considered but they are not persuasive. Applicant traverses the rejection of claim 28 under 35 U.S.C. 112, first paragraph, on the grounds that bioabsorbable surgical instruments are known in the art. Applicant supports this statement by citing U.S. Patent No. 6,015,410, which discloses a bioabsorbable surgical implant. However, the present invention is an abrasive rasp, not an implant. The material requirements for a rasp and a generic implant are different. Therefore, applicant must have disclose examples of usable materials at the time of filing.

Respecting the arguments to the rejections under 35 U.S.C. 102, applicant's arguments are persuasive and the rejections are withdrawn. However, new rejections under 35 U.S.C. 103 are applied.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Jacob Davis whose telephone number is (571) 272-4693. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DJD

GLENN K. DAWSON
PRIMARY EXAMINER